

### REMARKS

Upon entry of this Response, claims 1, 5, 7, and 9-25 are pending. Claims 1 and 12 are currently amended. New claims 13-25 have been added. No new matter has been added to the application. No fee for additional claims is due by way of this Response. The Director is authorized to charge any additional fees due by way of this Response, or credit any overpayment, to our Deposit Account No. 19-1090.

#### Examiner Interview

Applicants wish to thank the Examiner for the telephonic interview of December 14, 2006. During the interview, claim 1 and possible amendments to claim 1 were discussed. While no formal agreement was reached with regard to the allowance of claim 1, the discussion was very fruitful to an understanding between the parties. This Response is made in light of the telephone interview and, based upon the discussion, this Response is believed to place all claims in condition for allowance.

During the interview, U.S. Patent 6,788,635 (hereinafter "Aratani") and Japanese Publication JP 60-160036 (hereinafter "Takaoka '036") were discussed. The discussion of Takaoka '036 included reference to page 243, right side column, lines 4-5 (counted from the bottom of the page) and page 245, right side column, lines 13-18. With regard to page 245, right side column, lines 13-18, the Examiner admitted that Takaoka '036 does NOT disclose a recording film having a total thickness of 2 nm to 40 nm as alleged in the Office Action, but the Examiner alleged that Takaoka '036 discloses a total thickness in the range of 20 nm to 40 nm. During the interview, it was discussed that Takaoka '036 is in Japanese and that the Examiner does not read Japanese, nor does the undersigned representative of the Applicants.

#### The Office Action is Improper Under MPEP 706.02 and Should be Withdrawn

In the Office Action, claims 1, 5, 7, and 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani in view of Takaoka '036 or as being unpatentable over Aratani in view of Takaoka '036 and further in view of U.S. Publication 2003/0165111 (hereinafter "Flynn"). Takaoka '036 is a publication written in Japanese. The Examiner has

relied upon the text of Takaoka '036 in forming his rejections. Specifically, the rejection of claim 1 refers to Takaoka '036 at "[page] 246, right section, lines 6-12" and at "[page] 244, right column line 18 to left bottom column, line 2," and the rejection of claim 12 refers to Takaoka '036 at "[page] 245, right section, lines 13-18."

Applicants respectfully submit that the rejections are improper under MPEP 706.02 II, page 700-22, of Rev. 5, August 2006, which states in part:

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. ... the full text document [may] include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. ... In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action.

The multiple portions of Takaoka '036 cited by the Examiner are NOT written in English. Clearly, under MPEP 706.02 II, if the Examiner decides to rely upon the non-English portions of Takaoka '036, the Examiner must obtain an English language translation. One of the rationales for requiring a translation when the Examiner relies upon the full text is so that "the record is clear as to the precise facts the examiner is relying upon in support of the rejection." Another rationale is that "the full text [may] include teachings away from the invention that will preclude an obviousness rejection." The Examiner has admitted that he does not read Japanese. Therefore, Applicants request that the rejections based upon Takaoka '036 be withdrawn.

Takaoka Publication And U.S. Patent No. 4,682,321

Mr. Oishi, a patent attorney in Japan representing the Assignee, has provided the undersigned with a document entitled "Partial English Translation of Takaoka et al (JP 60-160036A)." According to Mr. Oishi, the document is a partial translation of Takaoka '036. In complying with the duty to disclose, the undersigned is providing a copy of the document to the Examiner. This translation should be provided to Applicants.

U.S. Patent No. 4,682,321 by Takaoka et al. (hereinafter "Takaoka '321"), which claims priority to Japanese Application JP 59-14058, is also provided to the Examiner. JP 59-14058 is listed on the front sheet (page 243) of Japanese Publication JP 60-160036A.

Rejections Under 35 U.S.C. § 103(a)

Claims 1, 5, 7, and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Aratani in view of Takaoka '036.

Independent claim 1 recites, *inter alia*, "a light transmission layer and a plurality of recording layers ... a reflective film containing Ag as a primary component and C as a secondary component." (Emphasis added.) The Office Action relies upon Aratani for disclosing an optical recording medium having a plurality of recording layers and a reflective film containing Ag and C. In particular, the Office Action cites column 10, lines 18-28, for disclosing the reflective film containing Ag and C. Applicants respectfully submit that Aratani teaches away from having C in a reflective layer when the recording medium has multiple recording layers. Column 10, lines 18-28, describes Aratani's single recording layer embodiment as illustrated in Figure 1. (See, column 10, lines 50-52, Aratani states that the preceding discussion was for the single recording layer embodiment of Figure 1.) At column 11, lines 1-22, Aratani discusses the reflective film for the multiple recording layer embodiment of Figure 2. Aratani discloses the reflective film might be of the form  $Ag_{100-x}X_x$  or of the form  $Ag_{100-x-z}X_xZ_z$ . At column 11, lines 5-7, Aratani discloses that for the  $Ag_{100-x}X_x$  reflective film X is chosen from Ge, Ni, Si, Tb, Fe, Al, Ti, Pd, Cr and Au. At column 11, lines 17-19, Aratani discloses that for the  $Ag_{100-x-z}X_xZ_z$  reflective film "X being at least one element selected from Ge, Ni, Si, Tb, Fe, Al, Ti, Pd, Cr and Au and Z being at least one element besides the X selected from those elements." (Emphasis added.) In other words, X is selected from Ge, Ni, Si, Tb, Fe, Al, Ti, Pd, Cr and Au and Z is selected from Ge, Ni, Si, Tb, Fe, Al, Ti, Pd, Cr and Au so long as the selected Z element is different from the selected X element. Thus, for the embodiment having multiple recording layers Aratani discloses two forms of reflective films,  $Ag_{100-x}X_x$  and  $Ag_{100-x-z}X_xZ_z$ , and C is NOT listed as one of the elements for the reflective film in that embodiment. Certainly, Aratani knew of the element C, but did not include it on the list of multiple recording layers.

Thus, Applicants respectfully submit that Aratani teaches away from Applicants' claimed "plurality of recording layers ... [and] a reflective film containing Ag as a primary component and C as a secondary component." Applicants respectfully submit that Takaoka '036 also apparently fails to disclose the aforementioned limitation. Thus, Aratani and Takaoka '036, individually and collectively, fail to teach or suggest the limitations of claim 1, and therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claim 12 recites, *inter alia*, "the first recording film and the second recording film are formed so that a total thickness thereof is 2 nm to 40 nm." The Office Action relies upon Takaoka '036 for allegedly disclosing the claimed limitation. For at least the reason that the rejection is improper under MPEP 706.02 II, Applicants respectfully request that the rejection of claim 12 be withdrawn.

#### New Independent Claims

Independent claim 15 corresponds to the previously presented claim 1 with the exception that Bi and Ge have been deleted from the list of elements forming the primary component of the first recording film and Ag and Al have been deleted from the list of elements forming the primary component of the second recording film. Thus, claim 15 recites, *inter alia*, "a first recording film containing one kind of element selected from a group consisting of Si, Sn, Mg, C, Al, Zn, In, and Cu as a primary component and a second recording film ... containing one kind of element from a group consisting of Cu, Zn, and Si." Applicants submit that Takaoka '036 apparently fails to disclose the claimed limitation. In the rejection of previously presented claim 1, the Office Action cites Takaoka '036 at page 246, right column, lines 6-12, for disclosing Ge as a primary component of the first recording layer and Al as the primary component of the second recording film. New claim 15 does not include Bi or Ge as an element that can be selected as the primary component for the first recording film and does not include Al or Ag as an element that can be selected as the primary component for the second recording film. It is believed that Takaoka '036 and Takaoka '321 thus fail to disclose the limitations of claim 1.

Independent claim 21 corresponds to the previously presented claim 12 written in independent form. It is believed that Takaoka '036 and Takaoka '321 fail to disclose the limitations of independent claim 21.

Conclusion

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,  
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